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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,135	09/10/1999	DR. HOLGER K. ESSIGER	NAES1980	3773

30996 7590 05/21/2003

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EXAMINER

LUCCHESI, NICHOLAS D

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 05/21/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/394,135

Applicant(s)

Essiger

Examiner

Nick Lucchesi

Art Unit

3764



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/24/2003 and 3/24/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 40 is/are allowed.
- 6) ☒ Claim(s) 7-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's remarks filed in the response of 2/24/2003 and 3/24/2003 have been carefully reviewed, with the following effect:

(1) With regard to the Branemark reference, the examiner acknowledges the priority dates accorded applicant with respect to the foreign filed German applications. Thus, the 102(e) rejection given previously is not applicable. A new 102(a) rejection has been given, since the priority date of the translated application 198 03 628.0 is 2/1/1998, which is predated by the 12/31/1997 PCT Publication Date of the Branemark reference.

(2) With regard to the Esser reference, it is noted that the Esser reference claims the benefit of provisional application 60/019,932 which has a filing date of 6/14/1996, which is thus the 102(e) date of the reference. Accordingly, the rejection stands.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Esser.

Esser discloses a bending-resistant bar having a flat cross-section and comprising two end portions 44 (see fig. 3). Note the bridging (raised) portion 46. The end portions have penetrations 48 adapted to receive fastening means for attaching the bar to bone.

4. Claims 8-13,17-39 are rejected under 35 U.S.C. 102(a) as being anticipated by Branemark '938.

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Branemark discloses a device for reshaping human or animal bone, comprising at least two spaced apart implants 8 which have a smooth mantle surface and a blind threaded bore, the implants receiving fasteners 17 which are used to affix a bending resistant bar 3 thereto. The bar 3 has penetrations 15 which appear to be slotted holes. Note that the bar has a flat cross section, and has a convex side and a concave side.

Branemark does not show areas of reduced cross sectional size in the bar to define bending locations therein.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Branemark in view of Esser.

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Esser discloses the use of cutouts (reduced cross sections) along the length of a bar type implant.

It would have been obvious to one skilled in the art to include areas of reduced cross sectional size in the bar of Branemark, as shown by Esser, if one wished to apply slight bends to the bar to assure that it conforms anatomically to a patient.

*Allowable Subject Matter*

7. Claims 1-6,40 are allowed.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nick Lucchesi whose telephone number is (703) 308-2698.

  
Nick Lucchesi

May 19, 2003

  
**NICHOLAS D. LUCCHESI**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**